

Client Ref: PIP-14-WHIT  
7791-0068-25

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

RE APPLICATION OF:

PHILLIP WHITE : GROUP ART UNIT: 2162

SERIAL NO. 09/317,110 :

CPA FILED: APRIL 4, 2001 : EXAMINER: LASTRA, D.

FOR: PROCESS, SYSTEM AND COMPUTER  
READABLE MEDIUM FOR IN-STORE PRINTING OF ...

REQUEST FOR ENTRY OF REPLY BRIEF

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

SIR:

C.F.R §1.1923(b)(1) indicates that an appellant may file a reply brief to an examiner's answer within two months from the date of the examiner's answer.

Accordingly, submitted herewith is a Reply Brief in response to the Examiner's Action of December 28, 2001, and Appellant requests continuation of the appeal.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

Date

2-26-02



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37 CFR § 1.193 REPLY BRIEF

ASSISTANT COMMISSIONER FOR PATENTS

WASHINGTON, D.C. 20231

SIR:

In response to the Examiner's Answer of December 28, 2001, Appellant submits the following Reply Brief under 37 C.F.R. §1.193(b)(1).

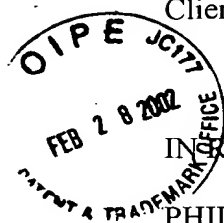
Claims 1-32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Off et al (U.S. Pat. No. 5,612,868) in view of Fajkowski (U.S. Pat. No. 5,905,246).

To establish prima facie obviousness of a claimed invention all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The teaching or suggestion to make the modification or combination of prior art and the reasonableness of success must both be found in the prior art. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Further, the proposed modification can not

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render the prior art unsatisfactory for its intended purpose. *In re Gordon*, 733 F.2d 900,221. USPQ 1125 (Fed. Cir. 1984).

In the Examiner's Answer of December 28, 2001, and in response to the Appellant's argument that combining the noted features of Fajkowski with Off et al is improper in that the proposed modification of Off et al renders Off et al unsatisfactory for its intended purpose, the Examiner's Answer asserts that 'the Fajkowski system would use the point of sale system described in Off et al to implement its coupon selection and raincheck generation process' (Examiner's Answer, page 21, lines 18-20).

However, the coupon selection and raincheck generation process of Off et al is based on "details of the coupon deal which are not communicated to the customer prior to the processing the customer order" (Off et al, Abstract, lines 11-13 and independent Claims 3-5, for example) or based on "details of the coupon deal and without the intervention or participation of the customer other than his or her action concerning the purchase of the triggering product" (Off et al, col 2, lines 30-33 and independent Claims 1-2, for example).

Yet, Fajkowski disclose that:

The display screen allows ***the user to view information*** concerning each coupon such as what product is represented by the coupon and the discount provided by the coupon. The microprocessor and operational keys allow ***the user to initiate the scanning of bar codes*** and arrange into various categories the coupons in the memory of coupon card, while the communications port will allow the transfer of coupon bar codes to a periphery device, another component of the system. Additionally, the coupon card may include an identification number which will allow the provider of the coupon card services to identify each individual to whom a coupon card is registered. The coupon card will allow ***users to scan large numbers of coupon bar codes*** directly from the FSI containing the coupons wherever the FSI may be found; thereby completely eliminating the necessity of clipping out, sorting and transporting a large number of paper coupons. Because the user of the coupon card is identifiable, the purchase habits of these individuals may be collected as marketing data regardless of whether or not the user pays with cash. (Fajkowski, column 3, line 60, to column 4, line 14.) [emphasis added]

Hence, coupon intervention and participation is central to the coupon selection process of Fajkowski. To add as proposed in the Examiner's Answer the raincheck and coupon selection system of Off et al which does not communicate the details of the coupon deal to the customer prior to the processing the customer order or which acts without the intervention or participation of the customer other than his or her action concerning the purchase of the triggering product to the Fajkkowski system would render Fajkowski unsatisfactory for its intended purpose of allowing customer intervention, viewing, and coupon selection. Thus, this combination is improper.

On the other hand, to combine the incentive processor of Fajkowski to the system of Off et al would then require in Off et al intervention by the customer, in participating in the coupon selection and raincheck generation process, rendering Off et al unsatisfactory for its intended purpose (Appeal Brief of October 3, 2001, page 10, lines 9-19).

Thus, either combination of Fajkowki and Off et al renders one or the other of the applied prior art references unsatisfactory for its intended purpose, making either combination improper.

Thus, for the above-stated reasons, the combination of Off et al with Fajkowski and the recently proposed combination of Fajkowski with Off et al are both improper, and the 35 U.S.C. § 103 rejection should be withdrawn.

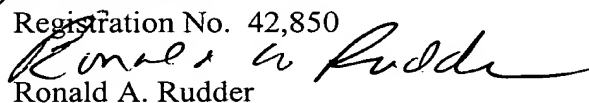
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